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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/001,981 | 12/05/2001 | Kenichi Yoshida | ASA-1041-02 | 6431 |
| 7590 | 07/21/2005 | | EXAMINER | |
| MATTINGLY, STANGER & MALUR, P.C. Suite 370 1800 Diagonal Road Alexandria, VA 22314 | | | JAIN, RAJ K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2664 | |

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/001,981 | YOSHIDA ET AL. |
| | Examiner Raj Jain | Art Unit 2664 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 December 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/5/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 12-18 examined on the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-11 of copending Application No. 09/987,816. The conflicting claims are identical, and therefore are not patentably distinct from each other.

Comparison of the two applications:

Claim 11 of current application (10/001,981) includes an method for access point of an internet provider to connect to a mobile/wireless terminal by first detecting available access points and than obtaining the best access point to connect with.

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Similarly, claim 5 of copending Application No. 09/987,816 also discloses an method for access point of an internet provider to connect to a mobile/wireless terminal by first detecting available access points and than obtaining the best access point to connect with.

Claim languages of both claims are phrased differently to claim the same invention, thus they are not patentably distinct from each other

Claims 13-18 of the present application are same to claims 6-11 respectively of the co-pending Application No. 09/987,816.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishino (US006233452B1).

Regarding claim 12, Nishino discloses a method of connecting a mobile terminal (Fig. 1) provided with a wireless communication unit with the internet (Fig. 3), comprising the steps

- detecting a communicable public line connecting device to be connected with a public line (see abstract, Fig. 3, col 2 lines 35-60, col 3 lines 44-54, col 3 line 64- col 4 line 5, a wireless device detects available access points within its serving area that in-turn is connected to a master serving station further connected to a PSTN or the like); and obtaining information about access points of an Internet provider from said detected public line connecting device (see Figs. 1 & 3, col 4 lines 14-25, col 9 lines 3-11, lines 25-40, access point information once obtained is stored within a memory module of the wireless unit for retrieval and connection later as appropriate).

Regarding claim 13, Nishino discloses visual display output of any acquired information so desired (see Fig.1, col 5 lines 37-45).

Regarding claim 14, Nishino discloses connecting to an obtained access point (see Figs. 1 & 3, col 4 lines 14-25, col 9 lines 3-11, lines 25-40, access point information once obtained is stored within a memory module of the wireless unit for retrieval and connection later as appropriate).

Regarding claim 15, Nishino discloses toll information of public line from connecting device (see table 1, col 12 lines 55 –67).

Regarding claim 16, Nishino discloses visual display output of any acquired information so desired (see Fig.1, col 5 lines 37-45, table 1, col 12 lines 55-67).

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Regarding claim 17, Nishino discloses accessing a mobile terminal with the access point selected through the public line connecting device selected on said obtained access point and toll (see col 2 lines 40-50, col 9 lines 3-40) a user will access an internet service based on selectable locations and service cost based on available access points either via PC or wireless device as appropriate.

Regarding claim 18, Nishino discloses enabling mobile terminal to provide public line connecting device with the information for specifying one provider (see col 3 lines 44-47 col 4 lines 10-20, once the wireless device obtains the required access point information, it than retrieves one of the access points that is associated with a current wireless base station and attempts an connection to the retrieved access point.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raj Jain whose telephone number is 571-272-3145. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

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R. Jain

RJ
July 19, 2005